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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,126	04/02/2004	Miles Libbey	08226/1200320-US1	1506
38880	7590	03/21/2008	EXAMINER	
Yahoo! Inc. c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770			NGUYEN, DUSTIN	
			ART UNIT	PAPER NUMBER
			2154	
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			03/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,126

Applicant(s)

LIBBEY ET AL.

Examiner

DUSTIN NGUYEN

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Response to Arguments

2. Applicant's arguments filed 12/10/2007 have been fully considered but they are not persuasive.
3. As per remarks, Applicants' argued that (1) neither Benowitz nor Wilson teach or suggest the amended limitation of "disabling the client's outbound message usage until the visual challenge is resolved, wherein disabling the client's outbound message usage occurs prior to sending an outbound message for the client".
4. As to point (1), as mentioned in the previous Office Action, Wilson discloses an active e-mail filter with challenge-response, wherein the challenge includes a moving or changing images [Figures 5 and 6; and paragraphs 0079 and 0080]. As shown in Figure 2, the system of Wilson will generate and send the challenge, then it will wait for the response. Wilson specifically discloses a maximum response time is preferably implemented; failure to respond correctly in the allotted time leads to the original message being blocked and the sender's address being put in the Blocked list, and if the sender does respond, then the response is checked to determine if it is corrected, if it is, then the sender's address is put in the Approved list and the original message

is passed to the recipient [i.e. disabling the client's outbound message usage until the visual challenge is resolved, wherein disabling the client's outbound message usage occurs prior to sending an outbound message for the client] [Figure 2; and paragraphs 0053-0059].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benowitz et al. [US Patent Application No 2003/0236847], in view of Wilson [US Patent Application No 2004/0015554].

7. As per claim 1, Benowitz discloses the invention as claimed including a method for managing outbound message usage [i.e. method for controlling incoming communication such as email to limit receipt of unsolicited and/or unwanted communications] [Figure 1A; and paragraph 0003], comprising:

determining a count of each recipient for each outbound message associated with a client; if the count of each recipient is at least equal to a limit over at least one period of time [i.e. restrict an sender to a limited number of email messages over a specified period of time] [paragraphs 0108 and 0115].

Benowitz does not specifically disclose

providing a visual challenge to the client; and

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved, wherein disabling the client's outbound message usage occurs prior to sending an outbound message for the client.

Wilson discloses

providing a visual challenge to the client [i.e. image-based challenged] [Figure 5; Abstract; and paragraphs 0024 and 0077]; and

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved, wherein disabling the client's outbound message usage occurs prior to sending an outbound message for the client [Figure 2; and paragraphs 0053-0059].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Benowitz and Wilson because the teaching of challenge-response in Wilson would provide a mechanism for eliminating or at least greatly reducing the successful transmission of unwanted e-mail while still making it easy and convenient to receive wanted e-mail [Wilson, paragraphs 0002 and 0022].

8. As per claim 2, Wilson discloses if at least one outbound message associated with the client is indicative of spam for at least one recipient, providing the visual challenge to the client [i.e. spam or unwanted message] [Figure 2; and paragraphs 0004, 0022 and 0037].

9. As per claim 3, Wilson discloses wherein the visual challenge further comprises an auditory challenge, and wherein until at least one of the visual challenge and the auditory challenge is resolved, disabling the client's outbound message usage [i.e. audio file or audio clip] [paragraphs 0024 and 0080].

10. As per claim 5, Wilson discloses wherein the visual challenge further comprises an auditory challenge, and wherein the auditory challenge includes at least one sound clip that is filtered to distort the playing of the sound clip for the auditory challenge [paragraphs 0024 and 0080].

11. As per claim 6, Wilson discloses determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage [i.e. allow another try if response is not correct] [Figure 2; and paragraphs 0063 and 0065].

12. As per claim 7, Wilson discloses if the provided visual challenge is unresolved over a predetermined period of time, disabling the client's outbound message usage [i.e. add to block list] [Figure 2; and paragraphs 0053 and 0056].

13. As per claim 8, Wilson discloses if the visual challenge is resolved, resetting the count for each recipient of each outbound message associated with the client [paragraphs 0063 and 0072].

14. As per claim 9, Benowitz discloses wherein a type of the message includes at least one type of email, blog, message board, Short Message Service (SMS), Multi-Media Message Service (MMS), and instant messaging (IM) [Abstract; and paragraphs 0003 and 0006].
15. As per claim 10, Benowitz discloses if the client's outbound message usage is disabled, providing instructions for an out of band communication by the client for re-enabling the client's outbound message usage [i.e. notify] [221, Figure 1C; and paragraphs 0024 and 0037].
16. As per claim 11, Benowitz discloses employing a recipient count statement to determine the count for each recipient for each outbound message associated with the client, wherein the recipient count statement determines at least one of a current hour recipient count, a current daily recipient count, and a total recipient count [i.e. usage term] [paragraphs 0035, 0092, 0108].
17. As per claims 12-20, they are rejected for similar reasons as stated above in claims 1-3 and 6-11.
18. As per claims 21-29, they are rejected for similar reasons as stated above in claims 1-3 and 6-11.
19. As per claim 30, it is rejected for similar reasons as stated above in claim 1.

20. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benowitz et al. [US Patent Application No 2003/0236847], in view of Wilson [US Patent Application No 2004/0015554], and further in view of Burrows et al. [US Patent No 7,149,801].

21. As per claim 4, Benowitz and Wilson do not specifically disclose wherein the visual challenge includes at least one Captcha test. Burrows discloses wherein the visual challenge includes at least one Captcha test [col 3, lines 19-25; and col 25, lines 36-46]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Benowitz, Wilson and Burrows because the teaching of Burrows would enable to create puzzles that can be solved only by humans, for the purpose of telling humans and computers apart over a network [Burrows, col 3, lines 19-21].

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154